

REMARKS

Forty-two claims are currently pending in the present Application. Claims 1-42 stand rejected under 35 U.S.C. § 103(a), and claim 43 has previously been cancelled. Claims 1, 3, 12, 21, 23, and 32 are amended, and a new claim 44 is added herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

35 U.S.C. § 103

On page 2 of the Office Action, the Examiner rejects claims 1-3, 5-6, 9, 11-23, 25-26, 29, and 31-42 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,779,549 to Walker et al. (hereafter '549) in view of U.S. Patent No. 6,168,522 to Walker et al. (hereafter '522), and further in view of U.S. Patent No. 6,200,216 to Peppel (hereafter Peppel). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when

combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the devices of '549 and '522 according to the teachings of Peppel would produce the claimed invention. Applicants submit that '549 and '522 in combination with Peppel fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither '549, '522, nor Peppel contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of independent claims 1 and 21, Applicants respond to the Examiner's §103 rejection as if applied to amended independent claims 1 and 21 that now recite performing "*a trading transaction for negotiating a transfer of ownership rights of an electronic certificate that represents a non-monetary based prize awarded as a part of said electronic gaming, said trading transaction being conducted directly between a source device from said one or more user devices and a target device from said one or more user devices,*" which are limitations that are not taught or suggested either by the cited references, or by the Examiner's citations thereto.

The Examiner states that the transfer described in '522 "is essentially a gaming prize as it is a representation of the balance accrued as the user has played and won on the gaming device." Applicants respectfully disagree with this interpretation of the teachings of the '522 reference. Applicants submit that an "electronic certificate that represents a prize" as claimed by Applicants is substantially different than a "current balance" of a "slot machine" as disclosed in '522. Furthermore, Applicants disclose and claim a complete and negotiated "transfer of ownership rights", while '522 merely discloses that "players may share funds" with other players in the gaming network by effecting a funds transfer.

In the present Office Action, the Examiner concedes that neither '529 nor '522 teach "negotiating a transfer" as claimed by Applicants. Applicants concur. The Examiner then cites Peppel to purportedly remedy this defect. The teachings of Peppel are limited to applying a traditional "trading card metaphor" to consumer digital media (see page 2, paragraphs 0020-0021). Applicants submit that the "electronic trading cards" of Peppel are not "an electronic certificate that represents a prize awarded as a part of said electronic gaming," as taught and claimed by Applicants. Peppel nowhere teaches or discloses electronic trading cards that are prizes awarded as part of electronic gaming.

In addition, the Examiner states with regard to Peppel that "[t]he cards are traded in an online environment." In contrast, Applicants specifically claim a "trading transaction being conducted directly between a source device from said

one or more user devices and a target device from said one or more user devices.” Applicants therefore submit that in certain claimed embodiments, the trading transactions of Peppel are significantly different from those taught and claimed by Applicants.

With regard to claim 42, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 which are further discussed below. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof.

Applicants respectfully submit that, in light of the substantial differences between the teachings of the cited references and Applicants’ invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of cited references. Applicants specifically direct the Examiner’s attention to Applicants’ discussion of FIGS. 3, 8, and 11 (Specification, page 13, line 6 through page 16, line 3, page 22, line 24 through page 24, line 3, and page 26, line 30 through page 28, line 18) which describes in detail one embodiment for the Applicants’ claimed “means for managing” and “means for communicating”.

Regarding the Examiner's rejection of dependent claims 2-20 and 22-40, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested.

In addition, with regard to claims 12 and 32, Applicants submit that the cited references fail to teach that "system users periodically utilize said one or more user devices to place wagers for gambling activities related to one of said electronic gaming and a live event, said wagers being of variable values depending upon wager amount choices selected by said system users," as claimed by Applicants. The Applicants therefore respectfully request reconsideration and allowance of dependent claims 12 and 32 so that these claims may issue in a timely manner.

With regard to claims 18 and 38, Applicants submit that the cited references fail to teach "downloading appropriate security software from said event server if said adequate security means are not currently available for completing said transfer procedure," as claimed by Applicants. The Applicants therefore respectfully request reconsideration and allowance of dependent claims 18 and 38 so that these claims may issue in a timely manner.

With regard to claims 19 and 39, Applicants submit that the cited references fail to teach an electronic certificate that is "updated to reflect a

change of said ownership rights,” as claimed by Applicants. The Applicants therefore respectfully request reconsideration and allowance of dependent claims 19 and 39 so that these claims may issue in a timely manner.

With regard to claims 20 and 40, Applicants submit that the cited references fail to teach transferring an electronic certificate by utilizing a “direct transfer path passing directly from said source user device to said target user device,” as claimed by Applicants. The Applicants therefore respectfully request reconsideration and allowance of dependent claims 20 and 40 so that these claims may issue in a timely manner.

In the rejections of claims 5, 6, 16-20, 25, 26, and 36-40, the Examiner repeatedly makes similar arguments regarding the purported non-criticality of certain elements of Applicants’ claims based upon Applicants’ discussion of potential alternate embodiments in the Specification. Applicants have never made any representations regarding whether certain elements of their invention are critical or non-critical. However, Applicants respectfully point out that obviousness, not criticality, is the proper standard for determining patentability under 35 U.S.C. § 103(a). Applicants therefore submit that the current rejections are improper, and respectfully request the Examiner to reconsider the current grounds of rejections for claims 5, 6, 16-20, 25, 26, and 36-40, so that these claims may issue in a timely manner.

In the rejections of claims 5, 6, 25, and 26, the Examiner repeated states that various claimed limitations are “well known” as support for the rejections

without providing any specific references for support. It appears that the Examiner is utilizing Official Notice without expressly stating so. Applicants respectfully submit that the claimed limitations in the particular claimed combination were not necessarily well-known to one skilled in the art at the time of the invention. For example, providing a gaming device with the claimed “profile module”, “certificate handling module”, or “trading module” would seem to provide sufficient “reasonable doubt” for properly questioning the Examiner’s use of Official Notice.

Applicants therefore respectfully request the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 5, 6, 25, and 26, so that the present Application may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 1-3, 5-6, 9, 11-23, 25-26, 29, and 31-42 are not unpatentable under 35 U.S.C. § 103, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 1-3, 5-6, 9; 11-23, 25-26, 29, and 31-42 under 35 U.S.C. § 103.

On page 11 of the Office Action, the Examiner rejects claims 4 and 24 under 35 U.S.C. § 103 as being unpatentable over ‘549 and ‘522 in view of Peppel, and further in view of U.S. Patent No. 6,409,602 to Wiltshire et al.

(hereafter Wiltshire). The Applicants respectfully traverse these rejections for at least the following reasons.

As discussed above, dependent claims 4 and 24 are indirectly dependent from respective independent claims 1 and 21 whose limitations are not identically taught or suggested. The limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are therefore also not identically taught or suggested.

For at least the foregoing reasons, the Applicants submit that claims 4 and 24 are not unpatentable under 35 U.S.C. § 103, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 4 and 24 under 35 U.S.C. § 103.

On page 12 of the Office Action, the Examiner rejects claims 7 and 27 under 35 U.S.C. § 103 as being unpatentable over '549 and '522 in view of Peppel, and further in view of U.S. Patent No. 5,947,825 to Horstmann et al. (hereafter Horstmann). The Applicants respectfully traverse these rejections for at least the following reasons.

As discussed above, dependent claims 7 and 27 are indirectly dependent from respective independent claims 1 and 21 whose limitations are not identically taught or suggested. The limitations of these dependent claims, when viewed

through or in combination with the limitations of the respective independent claims, are therefore also not identically taught or suggested.

For at least the foregoing reasons, the Applicants submit that claims 7 and 27 are not unpatentable under 35 U.S.C. § 103, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 7 and 27 under 35 U.S.C. § 103.

On page 13 of the Office Action, the Examiner rejects claims 8 and 28 under 35 U.S.C. § 103 as being unpatentable over '549 and '522 in view of Peppel. The Applicants respectfully traverse these rejections for at least the following reasons.

As discussed above, dependent claims 8 and 28 are indirectly dependent from respective independent claims 1 and 21 whose limitations are not identically taught or suggested. The limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are therefore also not identically taught or suggested.

In addition, Applicants submit that the cited references fail to teach “a certificate usage history that includes a chronological listing of various uses of said certificate,” or “a certificate transfer history that includes a chronological listing of ownership transfers of said certificate,” as claimed by Applicants. The

Applicants therefore respectfully request reconsideration and allowance of dependent claims 8 and 28 so that these claims may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicants submit that the cited references do not suggest a combination that would result in Applicants' invention, and therefore the obviousness rejection under 35 U.S.C §103 is improper.

The Examiner states "[o]ne of ordinary skill in the art would be motivated . . . as it would provide for all data in a single transmission." Applicants respectfully submit that a *general restatement of the advantages disclosed by the Applicants* deriving from implementation of the present invention cannot act as the required teaching or suggestion to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that "it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants' structure as a template and selecting elements from references to fill in the gaps." In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

For at least the foregoing reasons, the Applicants submit that claims 8 and 28 are not unpatentable under 35 U.S.C. § 103, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request

reconsideration and withdrawal of the rejections of claims 8 and 28 under 35 U.S.C. § 103.

On page 14 of the Office Action, the Examiner rejects claims 10 and 30 under 35 U.S.C. § 103 as being unpatentable over ‘549 and ‘522 in view of Peppel, and further in view of Horstmann. The Applicants respectfully traverse these rejections for at least the following reasons.

As discussed above, dependent claims 10 and 30 are indirectly dependent from respective independent claims 1 and 21 whose limitations are not identically taught or suggested. The limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are therefore also not identically taught or suggested.

Furthermore, Applicants submit that the cited references fail to teach performing “bi-directional communications only to said selected ones of said one or more system users during said electronic gaming by utilizing audio headsets and user interfaces on said one or more user devices,” as claimed by Applicants. For at least the foregoing reasons, the Applicants submit that claims 10 and 30 are not unpatentable under 35 U.S.C. § 103, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 10 and 30 under 35 U.S.C. § 103.

New Claims

The Applicants herein submit additional independent claim 44 for consideration by the Examiner in the present Application. The new claim 44 recites a specific detailed embodiment for the implementation and utilization of Applicants' invention, as disclosed and discussed in the Specification. Applicants submit that newly-added claim 44 contains a number of limitations that are not taught or suggested in the cited references. Applicants therefore respectfully request the Examiner to consider and allow new claim 44, so that this claim may issue in a timely manner.

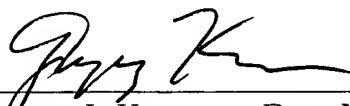
Summary

Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-42 and 44 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: 2/10/04

By:



Gregory J. Koerner, Reg. No. 38,519
SIMON & KOERNER LLP
10052 Pasadena Avenue, Suite B
Cupertino, CA 95014
(408) 873-3943